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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,157	03/25/2004	Chi Mun Ho	70031234-1	8343

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AGILENT TECHNOLOGIES, INC.
Intellectual Property Administration
Leagl Department, DL 429
P.O. Box 7599
Loveland, CO 80537-0599

EXAMINER	
OSORIO, RICARDO	
ART UNIT	**PAPER NUMBER**
2629	

MAIL DATE	DELIVERY MODE
05/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/810,157	HO ET AL.	
	Examiner	Art Unit	
	RICARDO L. OSORIO	2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 11/215,180. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application 10/810,157 contains all the limitations of claim 1 of co-pending application 11/215,180, however, claim 1 of 10/810,157 is broader. The omission of an element and its function where not needed is obvious. Ex parte Rainu, 168 USPQ 375 (PTO Bd. Of App. 1969). The omission of an element and its function in a combination is an obvious expedient if

the remaining elements perform the same as before. In re Karlson, 136 USPQ 184 (CCPA 1963).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 11/484,377. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application 10/810,157 contains all the limitations of claims 1 and 2 of co-pending application 11/484,377, however, claim 1 of 10/810,157 is broader than claims 1 and 2 of 11/484,377. The omission of an element and its function where not needed is obvious. Ex parte Rainu, 168 USPQ 375 (PTO Bd. Of App. 1969). The omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same as before. In re Karlson, 136 USPQ 184 (CCPA 1963).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 7, 8, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Baharav et al. (7,176,905)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Baharav discloses a switch panel comprising a touch plate (Fig. 1, ch. 12) comprising an optically transparent layer having first and second sides (col. 2, lines 40-41), said optically transparent layer having an index of refraction greater than that of air (see col. 5, lines 38 and 39. It is inherent that for internal reflection to exist in this transparent layer or window 12, the index of refraction has to be greater than air);
an image generator that displays an image comprising a plurality of button positions to a person viewing said touch plate from said first side (see col. 1, lines 26-31), an imaging system that records an image of said first surface of said touch plate (Fig 1, ch. 18);
a controller that is responsive to said image and generates an output signal if said touch plate is touched at one of said button positions (Fig. 1, ch. 20); and
a light source that generates a light signal that is reflected between said first and second sides of said touch plate within said transparent layer (Fig. 7B, ch. 34, and col. 5, lines 27-44).

As to claims 7 and 8, Baharav discloses said light signal comprising light of a probe wavelength and said image generator generates an image that is devoid of light of said probe wavelength wherein said imaging system selectively images light of said probe wavelength (see col. 5, lines 52-57. It is inherent that since the light emitted from the light source is used for touch detection, that the image generated by an image generator for displaying the image of icons or buttons will be devoid from the narrow or prove wavelength range of the light source light).

As to claim 10, Baharav teaches of the image generator being comprising a programmable display (see col. 1, lines 26-31).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baharav in view of Alles et al. (4,542,375).

Regarding claims 2 and 3, Baharav does not specifically teach of a portion of said light signal is reflected toward said second surface at an angle greater than the critical angle in said optically transparent layer when said first surface is deformed sufficiently when touched with a force greater than a predetermined force.

Alles teaches of said light signal being reflected toward said second surface at an angle greater than the critical angle in said optically transparent layer when said first surface is deformed sufficiently when touched with a force greater than a predetermined force (see col. 3, lines 52-60, col. 6, lines 8-14, and col. 8, lines 4-10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply pressure to deform the surface sufficiently , as taught by Allen, in the device of Baharav because the larger the deformation, the greater the amount of light trapped, and this can be useful, for example, to select colors or hues in a graphical environment (see col. 8, lines 4-10).

8. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baharav in view of Fujimoto (6,061,177).

As to claims 4 and 5, Baharav is silent as to the optically transparent layer comprising plastic or glass.

Fujimoto teaches of an optically transparent layer comprising plastic or glass (see col. 9, lines 61-66).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the optically transparent layer made of plastic or glass , as taught by Fujimoto, in the device of Baharav because plastic and glass are commonly known in the art of optical touch panels to be preferably used as the touch surface so that light passes this surface for purposes of detecting selection and so that user sees the display image below the touchscreen.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baharav in view of Kasday (4,484,179).

As to claim 6, Baharav, further, does not specifically teach of a pressure deformable layer of optically transparent material bonded to a layer of non-deformable material.

Kasday teaches of a pressure deformable layer of optically transparent material bonded to a layer of non-deformable material (col. 4, lines 20-36).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the deformable layer bonded to a non-deformable layer, as taught by Kasday, in the device of Baharav to achieve total internal reflection (see col. 4, lines 29-36).

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baharav in view of Davis et al. (6,310,615).

As to claim 11, further, Baharav does not specifically teach that the image generator comprises a transparency.

Davis teaches of an image generator comprising a transparency (col. 25, lines 40-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the transparency, as taught by Davis, in the device of Baharav because it is well known in the art of touch panels that a background image to be used for example as reference for writing or for selecting can be projected on the touch surface from an overhead or slide projector.

Allowable Subject Matter

11. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricardo L. Osorio whose telephone number is 571-272-7676. The examiner can normally be reached on Monday through Thursday from 7:00 A.M. to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala whose telephone number is 571-272-7681.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to: 571-273-8300 (for Technology Center 2600 only)

Hand-delivered responses should be brought to the Customer Service Window at the Randolph Building, 401, Dulany Street, Alexandria, VA 22314.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RICARDO OSORIO
PRIMARY EXAMINER
Technology Division: 2629

RLO
April 25, 2007